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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,107	09/22/2005	Patrick Ferlin	1022702-000269	5675
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EXAMINER				
SAYALA, CHHAYA D				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
04/16/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

# Office Action Summary

**Application No.**

10/525,107

**Applicant(s)**

FERLIN ET AL.

**Examiner**

C. SAYALA

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

#### ***Claim Rejections - 35 USC § 102/Claim Rejections - 35 USC § 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 38-40, 42-43, 45-46, 50-52, 55-58, 60-61 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lindner et al. (US Patent 7070749).

The patent shows alkaline earth metals with phosphates as the anion added to precipitated silica (col. 1, lines 50-60). See also col. 2, lines 19-20 and col. 3, lines 33-

37. Example 1 shows the product was obtained from being spray-dried. The examples also show that the product resulted from a suspension, being filtered and dried. See col. 5. The claims are written in a product-by-process format and as such, it is the novelty of the instantly claimed product that needs to be established and not that of the recited process steps. *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 191 USPQ (CCPA 1976).

The remaining limitations are described in terms of physical properties that applicant has chosen to describe his product with, and because the Office does not have the resources to manufacture prior art products to make comparisons therewith, the burden is being shifted to applicant to do so.

2. Claims 38-40, 42-43, 45-46, 50-61 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schubert et al. (US Pub 2002/0061404).

Schubert's reference disclosure is similar to Lindner et al. It is to be noted that the assignee is the same. Claim 59 is shown at ¶0018. Also see ¶ 0025-¶0026. The phosphate content at claims 53 and 54 should be inherent or obvious because the patent expressly describes calcium phosphate as pointed out at 00200025-0026.

***Claim Rejections - 35 USC § 103***

3. Claims 41, 44, 47-49, 53-54, 55-59, 62-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindner et al. in view of Voit (US Pub 2001/0051176) and Kuhlmann et al. (US Pub 2002/0102198).

With regard to precipitated silica that includes calcium phosphate, Lindner et al. as discussed above, teaches such. Voit teaches using alkaline earth metals as well. Both secondary references teach precipitated silica as well and teach that the moisture content is less than 5 wt% (Voit, ¶0031), a solids content of about 22% (Voit, ¶0032), using a spray atomizer (Voit, ¶0087), spherical beads (Voit ¶ 0088), a packing density of more than 0.29 (Voit, claim 1), a comparable DOP of 250ml/100 g (Voit, claim 5), the pore volume diameter of less than 1 micrometer (Voit, ¶0088), the BET that falls within the claimed range (Voit, ¶ 0027), the beads are dust-free as in instant claim 63 (Voit, ¶ 0063), the silica contains vitamin E, choline and shows the silica containing such to be useful for animal feed (Voit, ¶ 0065-0066). Although Voit shows such characteristics, the reference does not disclose the anti-caking property of precipitated silica, although such use is well-known. Kuhlmann teaches the use of a precipitated silica as an anti-caking agent at ¶ 0026.

Even though the claims are to a compound, and finding a new use for a compound does not render the compound patentable, and as has been noted that the compound has been described by the process of making it, it has been well established that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In any event, since these patents all show the various aspects of the claimed invention, then to optimize these precipitated silica such that calcium phosphate is included in the silica and to follow the Voit reference in its description of using the silica as a carrier for liquids that find use as animal feed additives or anti-caking agents would have been obvious.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/C. SAYALA/  
Primary Examiner, Art Unit 1794**

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